Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

	Docket Number (Optional)
	U02-0022.20

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
on _August 15, 2005_	10/065,253	9-30-02
Signature _Patricia L. Pontello_	First Named Inventor HICKS	
	Art Unit	Examiner
Typed or printed name _PATRICIA L. PONTELLO_	2681	CAI, WAYNE HUU

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

[X] attorney or agent of record.
Registration number _41,329_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____ Signature

GREGORY A. STEPHENS
Typed or printed name

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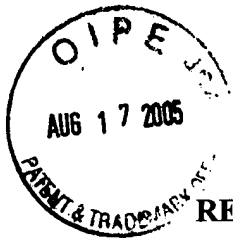Telephone number

AUGUST 15, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of __1__ forms are submitted.

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant submits that the current and immediately preceding office actions issued by the Examiner in the present application contain clear errors in the Examiner's rejections as well as omissions of one or more essential elements needed for a prima facie rejection.

The pending claims include four independent claims with corresponding dependent claims. The chief difference among the sets of claims is their characterization: method, means + function system, computer program product, and mobile phone apparatus. Most, if not all, of the elements and steps that form these claims are the same. Thus, the arguments made by the Examiner in his primary rejection were applied to each of the independent claims. As a result, the remarks herein also pertain to each of the independent claims even if not specifically stated.

The key elements and/or steps of the independent claims can be reduced to the following:

- A SIM card associated with (resident within) a mobile phone, the SIM card provisioned with (including) an IMSI file, an OPL file, and a PNN file
- Receiving an over-the-air control signal from a wireless service provider comprised of PLMN data and LAI data
- Comparing the received PLMN data to stored PLMN data within the mobile phone
- Further comparing, if necessary, the LAI data against data stored in the OPL file
- Further comparing, if necessary, the PNN file record to OPL file record relationship

The Examiner's rejection (See, ¶ 2 and 3 of Office Action dated 07/18/2005) applies the following portions of the McElwain reference to the elements cited above:

- **SID information** for receiving an over-the-air control signal from a wireless service provider comprised of PLMN data and LAI data
- **Received SID information against stored SID information** for comparing the received PLMN data to stored PLMN data within the mobile phone

- **SID Cousin List** for further comparing, if necessary, the LAI data against data stored in the OPL file
- **SID Cousin List (again)** for further comparing, if necessary, the PNN file record to OPL file record relationship

The Examiner clearly relies on the SID identifier in making the present rejections. The Examiner relies on ¶ 40 in McElwain that attempts to create a list of equivalents for the specific 15 bit SID. While PLMN data is specifically suggested by McElwain in ¶ 40, additional LAI control data such as any LAC identifiers are <u>not</u> contemplated by McElwain.

McElwain does perform a comparison between the received SID identifier against the stored SID identifier in the mobile phone in a fashion similar to the present invention comparing the received PLMN data to stored PLMN data. If that check comes back negative, McElwain suggests comparing the received SID to a SID cousin list (step D in Figure 4a).

In the present invention, however, if the initial PLMN check fails, then the additional LAI data is used to verify that the received PLMN/LAI data is in the OPL file (a list of PLMN codes that can specify either home or roaming networks). Even if this check passes, the present invention must still perform another check utilizing a separate file (PNN file) to make the final determination of home or roaming network.

It is in this last step that the Examiner completely fails to recite the same or even an equivalent step because the Examiner merely repeats his recitation of step D in Figure 4a. Thus, the Examiner has made a clear error in not finding a step/element identical to or even equivalent to the last step recited in the present invention "comparing, if necessary, the PNN file record to OPL file record"

The Examiner further admits that McElwain does not disclose a SIM card including an IMSI file, an OPL file, and a PNN file each having a record structure. For this the Examiner cites the Linkola reference. The Examiner <u>affirmatively</u> states that Linkola discloses a SIM card including an IMSI file, an OPL file, and a PNN file. While the IMSI file is specifically mentioned, the OPL file and PNN file are nowhere to be found in Linkola reference. Thus, the Examiner has incorrectly stated that Linkola discloses an

OPL file and a PNN file. Rather, the Examiner most likely assumed that the SIM card contained these files. To compound matters, the Examiner in his "Response to Arguments" employs erroneous if not circuitous logic when he states that,

"the Examiner combines Linkola with McElwain for the purpose of expressly including and/or utilizing a SIM card in the mobile phone regardless of the files being installed/contained in the SIM card. One skilled in the art would have known that the OPL and PNN files are contained in the SIM card based on the disclosure of McElwain because there must be a storage containing the related data so that the system could make the comparison, and determine whether the mobile phone is in home or roam network."

It is not known, at least by applicant, how one would know that the OPL and PNN files would be contained on a SIM card based on the disclosure of McElwain when neither McElwain nor Linkola mentions either the OPL or PNN files.

There is a reason that neither reference contemplates the OPL or PNN files. They are relatively new files that are used by the E-ONS (Enhanced Operator Name String) functionality to display the current network operator on the mobile phone's display when the mobile phone is in use. The present invention has determined a novel method for using the data in these files to also determine whether the mobile phone is currently in a home network or a roaming network in addition to displaying the current operator by name.
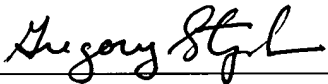
Thus, while E-ONS was never intended to determine home vs. roaming networks, the present invention has used the new E-ONS files (OPL and PNN) in a novel way to do just that.

McElwain merely compares a received SID to a stored SID and/or a cousin list of SIDs on the mobile phone. McElwain does not suggest the novel use of OPL and PNN files that contain specific record structures of the PLMN data. The steps recited in the present invention that include the OPL and PNN files have no literal or equivalent counterpart in McElwain despite the Examiner's assertions to the contrary.

In sum, the Examiner has not shown that McElwain reads on each of the elements and/or steps recited in the present invention which constitutes an omission of one ore more essential elements needed for a prima facie rejection. The present invention has been specifically claimed to include and read on systems that use the recited elements, namely PLMN data, LAI data, OPL files, and PNN files. Thus, the Examiner's substitution of "equivalent" parameters, identifiers, files, etc... (e.g., SID) in place of the actual parameters, identifiers, and files constitutes an omission of one ore more essential elements needed for a prima facie rejection.

In addition, the Examiner has not demonstrated that Linkola contains the requisite OPL and PNN files on the SIM card. Moreover, the Examiner has not provided any motivation for making the combination of McElwain and Linkola. The Examiner merely states it would have been obvious to one of ordinary skill in the art to modify McElwain's method of determining the home network. (See, p. 5, 1st ¶ of 07/18/05 Office Action). This is clearly insufficient under 35 USC 103(a).

Respectfully submitted,

Gregory Stephens 8/15/5

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